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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,533	03/27/2002	Jean Lemonnier	MCA-514 PC/US	3225

25182 7590 11/19/2003  
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EXAMINER
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MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/089,533	Applicant(s) LEMONNIER, JEAN	
	Examiner Krishnan S Menon	Art Unit 1723	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-53,55,56 and 61-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52 is/are rejected.
- 7) ☒ Claim(s) 36-51,53,55,56 and 61-68 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 36-53, 55-56 and 61-68 are pending

#### ***Double Patenting***

Applicant's amendments to application 10/088,325 and the present application has overcome the double patenting issue.

#### ***Abstract***

The newly submitted abstract is acknowledged

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 36, 37, 47-53, 55, 56 and 61-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al (US 5,308,483) in view of Lemonnier (US 5,288,638)

Sklar teaches a microbiological examination device having an intake body (10, fig 1-5), a filter membrane (37), a drainage body (30), intake body having a reservoir with input aperture (10), drainage body having means to support the membrane (34, 36), liquid output aperture (41; col 3 lines 37-44), integrally molded locking means (16, 38, 39 fig 2), membrane gripped between the intake body and the drainage body (fig 2), elastomer seal between the intake and drainage bodies (35; col 3 lines 4-45), locking means adapted to opening of the device by separation movement (col 1 lines 5-12) and

axially oriented tabs with latching means forming part of the drainage body as in claim 36 (see fig 1,2; col 3 lines 21-37).

Sklar does not teach the device as being adapted for use in a pressurized liquid filtration as in claim 36. Lemonnier teaches a device for microbiological testing of pressurized liquids having an inlet aperture (6) on the lateral wall (2), with liquid entering through the aperture and exiting through the membrane (see figures). It would be obvious to one of ordinary skill in the art at the time of invention to have the teaching of Lemonnier in the teaching of Sklar to have a device suitable for pressurized liquids as taught by Lemonnier (abstract) for accurate and safe checking of microbiological quality.

Membrane is held on account of the grip between the periphery of the first and second member (see fig 1 and 2) as in claim 37. Means for receiving the tab in the intake body and means for preventing withdrawal as in claim 47 (fig 1). Means for preventing withdrawal of the latching tab (39) as in claim 48. Tooth (39) and groove (16) as in claim 49 (fig 2). The lateral wall (13-fig 3) having a greater axial dimension than the axial dimension of the tab (fig 1-3) as in claim 50. Lateral wall has a notch (16; col 3 lines 28-31) to press on the tab as in claim 51. A number of such locking tabs possible as in claim 53 (col 3 lines 20-22). Locking means is exclusively axial as in claim 55 (see figures). Drainage body has a membrane support table and a wall (11) of the intake body providing a sealing surface with the membrane and the seal as in claim 56 (see fig 1-3). Support pad as in claim 59 (col 3 lines 10-22). Drainage body has drainage channels opening into the output aperture (see fig 2) as in claim 60. External dia of the circular table (34) corresponds to the internal dia of a skirt (13-fig 3) included

in the intake body and which encircles the support table as in claim 61 (13-fig 3), and has areas of extra thickness for wedging between the circular table and the skirt as in claim 62 (see fig 1,4). Drainage body has a skirt in step with the circular table as in claim 63 (see fig 2) and skirt has means for latching with intake body as in claim 64. Means for attaching a drainage syringe (col 3 lines 55-60) as in claim 65. Output aperture of the drainage body is in the continuation of the internal passage of a coaxially disposed output pipe as in claim 66 (See 42, fig 1-4). An annular, tapered, rib around the output pipe (unmarked annular member between the outlet wall 42 and part 31 of figures) as in claim 67.

Claim 54 adds further limitation to claims 36, that is four latching tabs which is not taught by Sklar. Sklar teaches only two tabs, but it would be obvious to one of ordinary skill in the art at the time of invention that four tabs is just replication (Note: mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*).

Claim 68 is a method claim using the device of claim 36 with additional limitations as in claim 67, wherein a vacuum flask is engaged with the device; the output pipe engaging the hole of the stopper of the vacuum flask and the annular rib resting on the stopper. Sklar has such an output pipe (42-fig 1) and teaches using vacuum means for the process (col 3 lines 55-68), but does not specifically teach using the vacuum flask. Nevertheless, it would be obvious to one of ordinary skill in the art at the time of invention that the structure of the drainage body of the Sklar device is suited specifically

to attach to such a vacuum flask, and one would use a vacuum flask for the vacuum connection taught by Sklar.

2. Claims 38-46 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar in view of Lemonnier as in claim 36 above, and further in view of Mehra et al (US 4,614,585).

Claims 38-46 and 57 have added limitations not taught by Sklar in view of Lemonnier as follows: Claim 38 has seal molded on to the first or second member; claim 39 has the seal molded on to the first member; claim 40 has the first member having the seal and forming a lateral wall having an edge forming part of the seal. Claim 41 has all the limitations of claim 40 and the edge of the lateral wall forming a groove, with the seal having a 'T' cross section, the longitudinal branch of the T inserted in the groove and the transverse branch forming a cushion to seal on the membrane. Claim 42 has all the limitations of claim 41 and a bevel between the rib and the cushion on the external side. Claim 43 adds further limitation to claim 41, two annular lips on the cushion where it is in contact with the membrane. Claim 44-46 has the locking tab having a breakable zone. Claim 57 has the limitations of claim 56 as taught by Sklar, and adds further limitation of a concave surface for the support. Mehra teaches the molded seal as in claims 38-43 (see 38, 42, fig 1-2; col 3 lines 10-24; bevel and lips – see part 40 fig 2); locking tab that is breakable as in claims 44-46 (col 3 lines 25-39); Concave surface of the support (16-fig 1,2) as in claims 57. It would be obvious to one of ordinary skill in the art at the time of invention to have the teaching of Mehra in the

teaching of Sklar for easy manufacture of the filter with molded parts; easy recovery of the membrane from the filter because of the seal structure, and as a one-use disposable device (see Mehra col 4 lines 10-15) with the breakable tabs.

### ***Allowable Subject Matter***

Claim 52 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claim 52 recites latching tabs suited for pressurized liquid filtration, the structure of which is different from the prior art, Sklar (483), because the latching tabs of Sklar are designed for quick attachment and disengagement, which need to withstand only internal vacuum, and not for withstanding the fluid pressure. Secondary ref Lemonnier uses threaded attachment, and therefore it is also not obvious to have the type of latching tabs of the instant claim.

### ***Response to Arguments***

Applicant's arguments filed 10/9/03 have been fully considered but they are not persuasive.

Argument re claim 36, pressurized liquid filtration, is moot due to the new ground of rejection.

Argument re the location of the gasket, claim recites "... second member having an elastomer seal by means of which it comes in contact with the membrane ...". Since the filter second member is part of the drainage body, it comes in contact with the membrane "by means of the elastomeric gasket 35 of the filter pad 36". Claim does not recite that the elastomeric gasket is in direct contact with the second member, and the second member *is* the drainage body. Even if it were so, the sealing arrangement would still be "equivalent".

Argument re claim 68: Sklar has an output pipe as claimed in claim 68, which could be connected to a vacuum flask.

Re argument that Mehra teaches friction fit of gasket and not integrally molding, the gasket is fitted to the member in Mehra, and the fit whether by method of integral molding or otherwise, would not matter in the apparatus claim. Also please see lines 48-53, col 3, which describe using gasket that is formed in place.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mehra teaches breakable tabs in a disposable filtration device in which the filter with the recoverable material can be quickly and easily recovered. Sklar also teaches disposable filter



device, but Sklar's device could be re-used and could result in unintended re-use. Mehra's "break away" unit prevents reuse (col 4 lines 9-15), and therefore, the motivation to combine.

Re argument that the references do not teach the present invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan Menon  
Patent Examiner

  
W. L. WALKER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700